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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,722	03/08/2002	Masahide Ogawa	P 290786 RIG500236-USA-A	7348
909 7590 07/21/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER BEKERMANN, MICHAEL				
ART UNIT 3622		PAPER NUMBER		
MAIL DATE 07/21/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/092,722

Applicant(s)

OGAWA, MASAHIRO

Examiner

MICHAEL BEKERMAN

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is responsive to papers filed on 2/15/2008.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 4 and 6-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (WO 00/21005).** Walker teaches a system and method for providing discounts for purchases between different merchants that includes all of the limitations recited in the above claims.

Regarding claims 4, 8, 11, and 14-16, Walker teaches offering a discount to a customer when that customer meets certain criteria with 2 (or more) merchants, that criteria including the purchase of specific item(s) from each merchant (Page 15 Lines 16-19, Page 16 Lines 9-16, Page 17 Lines 9-21, and Page 18 Lines 12-18). Walker also teaches a store code identifying each merchant (Figure 8 References 824, 832 and Figure 10 Reference 1024), an item code identifying each product for sale (Figure 10 Reference 1030), and a discount item flag identifying items as being subject to a discount (Figure 10 Reference 1020). Since Walker teaches that a criteria for offering the discount could be a required purchase from a 1st merchant and a criteria for

redeeming the discount could be a required purchase for a 2nd merchant, all items subject to this criteria must have the associated discount item flag. Walker further teaches notifying the purchaser of the obtainable discount (Page 15 Lines 18-19) and applying the discount should the criteria be met (products are purchased from the different respective merchants which is part of the criteria that needs to be met for the discount, so this meets the step of discrimination) (Page 18 Lines 13-16). While Walker teaches this process as taking place in an actual mall (Page 7 Lines 14-16 and Page 8 Lines 5-6), Walker also teaches this as taking place online (Page 8 Lines 7-9 and Page 23 Lines 13-16). Due to the multiple merchants that do business through it, the Internet is a virtual mall.

Regarding claims 6, 9, and 12, if two items are purchased from a merchant (regardless of the discount item flags), both items have been selected for purchase by the consumer.

Regarding claims 7, 10, and 13, Walker teaches offering a discount (Figure 10 Reference 1022) for the purchase of one of a set of particular items (Figure 10 Reference 1030) and/or a required purchase price threshold (Figure 10 Reference 1028). If the threshold is set at \$10, and multiple items are listed as required purchases (thus all of which would have discount item flags), one required item priced at \$5 would not have the discount applied while a required item with a higher price of \$15 would. This scenario is supported by Walker and is representative of the claim language.

Response to Arguments

2. **Applicant argues** “just because Walker may teach awarding a bonus to a customer for performing transactions at different merchants (i.e., the outputting and soliciting merchants), it does not necessarily follow that Walker teaches that the bonus is a discount that is achieved when the customer purchases at least one item subject to the discount from each of the outputting and soliciting merchants. Rather, in Walker individual items are not subject to the bonus - only transactions are. For example, in Walker the customer may receive a bonus, for example, expressed as a percentage off a transaction which may be unrelated to the item purchase.” Applicant continues “The cited portions of Walker, however, provide no indication that the customer must purchase an item subject to a discount from each of the outputting and soliciting merchants in order to receive a bonus.” Applicant is correct in the assertion that Walker teaches transaction-based bonuses. However, in response to the above arguments, Examiner will quote the portions of Walker below that precisely teach these portions of Applicant’s claimed invention:

- “The offer is provided to a customer if the customer satisfies criteria while participating in a first transaction with a first merchant. **The first merchant, known as an “outputting merchant”, outputs the offer for a bonus once the customer satisfies the criteria**” (Page 15, Lines 16-19).
- “The customer is required to participate in **a transaction with the outputting merchant** in order to receive the offer for the bonus. The customer may also be required to participate in the transaction at an indicated time, and **the transaction may be required**

to have an indicated purchase price and **include an indicated item**" (Page 16, Lines 9-12).

- "The bonus is typically awarded once the customer participates in a **transaction with a second (soliciting) merchant**, subject to the customer meeting the conditions" (Page 17, Lines 13-14).
- "The time of the **second transaction**, required purchase price at the **soliciting merchant**, and **required item to purchase** each represent a condition which the customer must meet in order to receive the bonus" (Page 17, Line 21 - Page 18, Line 2).

Further, Figure 10 of Walker is reproduced below with annotations indicating the teachings of an individual item subject to a bonus, not only a transaction:

1000

1002

1004

1006

1008

BONUS IDENTIFIER 1020	BONUS VALUE 1022	SOLICITING MERCHANT IDENTIFIER 1024	TIME OF TRANSACTION AT SOLICITING MERCHANT 1026	REQUIRED PURCHASE PRICE AT SOLICITING MERCHANT 1028	REQUIRED ITEM(S) TO PURCHASE 1030
D0001	10% OFF	M0002	ANY	> \$5.00	NONE
D0002	\$15 OFF	M0003	ANY	NONE	ITEM # 12345678
D0003	1/2 OFF SECOND PURCHASE PRICE, UP TO \$40	M0003	MONDAY - FRIDAY	NONE	NONE
D0004	5% OFF	M0001	SATURDAY, 9:00 - 12:00	> \$10.00	NONE

Money value the item is to be discounted by.

Only requires 1 item to purchase.

FIG. 10

3. **Applicant further argues** "While the bonus identifier 1020 (FIG. 10) of Walker (alleged by the Office Action to correspond to the claimed discount item flag), may include a required item to purchase 1030, if any, there is no indication that the bonus corresponds to the item to purchase 1030". Examiner is confused by this argument and may not entirely grasp Applicant's meaning. According to Figure 10 reproduced above, 1 item is required to be purchased. The bonus is \$15 off. If the required item is not purchased, there is no bonus. If the required item is purchased, there is a bonus. There is an explicit correlation between the bonus and the item.

4. **Applicant further argues** "While the first (outputting) merchant in Walker may notify a customer of a bonus for making a further transaction at a second (soliciting) merchant, Walker provides no indication that the first (outputting) merchant (or other features) notifies the customer that the purchased item is subject to a discount". Examiner has already cited above how the bonus is applied to a particular item (or transaction, Walker teaches both) after the purchase of a particular item from a first and second merchant. Examiner will quote the portions of Walker below that precisely teach these portions of Applicant's claimed invention:

- "The bonus value is typically expressed as, for example, **a percentage off the previous (first) transaction** during which the offer for the bonus was made. The bonus value may also be expressed as **a percentage off the current transaction**" (Page 18, Lines 3-5).
- "The first merchant, known as an "outputting merchant", **outputs the offer for a bonus** once the customer satisfies the criteria" (Page 15, Lines 18-19).

5. **Applicant further argues** "the Office Action has apparently ignored the means for recitation in claim 6 (which requires the Examiner to interpret the claim limitation in

light of the means disclosed in Applicant's specification". The means for selecting of Applicant's specification appears to merely refer to programming. Walker also teaches programming, and Examiner considers Walker's programming language to be equivalent to Applicant's programming language. As explained above, if 2 items are purchased from a merchant, both items have been selected within the system for purchase. This meets the broad claim language of "means for selecting".

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL BEKERMAN** whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622